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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,433	09/24/2003	Jan Weber	10527-626001 / 02-369	2417
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EXAMINER TYSON, MELANIE RUANO				
ART UNIT 3773		PAPER NUMBER		
NOTIFICATION DATE 12/03/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/670,433

Applicant(s)

WEBER ET AL.

Examiner

MELANIE TYSON

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11 and 19-43 is/are pending in the application.
- 4a) Of the above claim(s) 19-33 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11, and 34-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the applicant's amendment received 14 October 2009. The amendments made to the claims do not place the application in condition for allowance for the reasons set forth below. Claims 19-33 and 43 remain withdrawn from consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4-11, and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (U.S. Patent No. 5,817,017) in view of Pacetti (Patent No. 7,156,869 B1). Young discloses an implantable medical device (see entire document) comprising a support structure (tube) formed such that magnetic field changes proximate the support structure are substantially unobstructed, and a

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paramagnetic material (for example, gadolinium; see column 9, lines 43-44) embedded into at least part of the support structure (for example, see column 3, lines 48-57 and column 6, lines 12-15 and 36-48). Young fails to disclose the implantable device comprises a stent that may be formed from a metallic or biodegradable material. Pacetti discloses an implantable stent (see entire document) and suggests that metallic and biodegradable materials are well known in the art for forming such devices (for example, see column 10, lines 3-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply Young's technique to a stent, since stents are well known implantable devices, as evidenced by Pacetti. Doing so would render Pacetti's stent detectable by MRI techniques. With further respect to claims 3, 4, 6, and 34-40, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the tubular structure of a metallic or biodegradable material as recited, since it has been held to be within the general skill of a worker in the art to select known materials on the basis of its suitability for the intended use as a matter of design choice.

Regarding claim 5, the applicant submits that stents formed of a combination of materials, such as a polymer or ceramic material and a metallic material, are well known in the art (see page 3). Therefore, by applicant's own admission, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a stent comprising a metallic and at least one of a polymer and a ceramic material, since it has been held to be within the general skill of a worker in the art to

select a known material on the basis of its suitability for the intended use as a matter of design choice.

Regarding claim 8, Young discloses the claimed invention except for a ferromagnetic material. Young suggests that ferromagnetic material is well known in the art for making devices visible under MRI (for example, see column 1, lines 38-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use ferromagnetic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Regarding claims 10, 11, 39, and 40, Young recognizes that the magnetic material may be dispersed uniformly throughout the device or dispersed in a pre-selected pattern, to portions of the device that are desired to be viewed with magnetic imaging techniques (for example, see column 3, lines 14-22). Therefore, if only the ends of the implantable device are desired to be viewed with magnetic imaging techniques, it would have been obvious to one having ordinary skill in the art to apply the magnetic material only to those portions.

Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pacetti (Patent No. 6,712,844 B2) in view of Young et al. Pacetti discloses a stent comprising a tubular structure having a plurality of rings of electrically conductive material, connectors of electrically conductive material extending between and connecting adjacent rings, and electrical discontinuities, comprising insulating material (for example, see Figure 3, column 5, lines 56-57, column 6, lines 5-8, and column 7,

lines 1-3 and 28-43). Pacetti fails to disclose magnetic material embedded into the end portions of the tubular structure.

Young et al. discloses tubular insertable and implantable devices (see entire document). Young teaches embedding magnetic material into the tubular structures in order to enhance detectability when viewed with MRI techniques (for example, see column 3, lines 16-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to embed magnetic material into Pacetti's tubular structure. Doing so would enhance detectability during imaging, thus enhancing proper placement/deployment of the device.

With further respect to claim 41, Young recognizes that the magnetic material may be dispersed uniformly throughout the device or dispersed in a pre-selected pattern, to portions of the device that are desired to be viewed with magnetic imaging techniques (for example, see column 3, lines 14-22). Therefore, if only the ends of the implantable device are desired to be viewed with magnetic imaging techniques, it would have been obvious to one having ordinary skill in the art to apply the magnetic material only to those portions.

Response to Arguments

Applicant's arguments filed 14 October 2009 have been fully considered but they are not persuasive. The applicant argues primarily that since Young discloses the support structure is a polymeric material having a magnetic material incorporated into the matrix of the polymeric material, preferably before extrusion, Young fails to provide support for how to embed magnetic particles in a metallic support structure, and thus

one of ordinary skill in the art would have no reason to apply Young's technique to a metallic support structure. However, Young discloses, in addition to the technique argued by the applicant, that the magnetic material may be embedded into the support structure through other techniques, such as during extrusion, impregnation, compounding, chemical vapor deposition, etc. (for example, see column 11, line 59-column 12, line 11), all of which are known methods for applying materials to metallic stents. It is the examiner's position that it would have been obvious to one having ordinary skill in the art at the time the invention was made to embed magnetic material in a metallic support structure, such as a stent, in order to render the stent detectable by MRI techniques, and thus enhancing proper placing and deployment of the stent within the body.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE TYSON whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
November 26, 2009

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773